



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
|-----------------|-------------|----------------------|---------------------|------------------|

10/618,427

07/10/2003

David M. Van Wie

7451 0002-04

5616

22852

7590

04/30/2008

FINNEGAN, HENDERSON, FARABOW, GARRETT & DUNNER
LLP

901 NEW YORK AVENUE, NW
WASHINGTON, DC 20001-4413

EXAMINER

JOHNSON, CARLTON

ART UNIT

PAPER NUMBER

2136

MAIL DATE

DELIVERY MODE

04/30/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

| | | | |
|------------------------------|---------------------------------------|---------------------------------------|--|
| Office Action Summary | Application No. 10/618,427 | Applicant(s) VAN WIE ET AL. | |
| | Examiner Carlton V. Johnson | Art Unit 2136 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 10 July 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 30-53 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 30-53 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 10 July 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>See Continuation Sheet</u> . | 6) <input type="checkbox"/> Other: _____ |

Continuation of Attachment(s) 3). Information Disclosure Statement(s) (PTO/SB/08), Paper No(s)/Mail Date :5-21-2004 / 10-20-2004 / 9-14-2006.

DETAILED ACTION

1. This action is responding to application papers filed on **12-20-2002**.
2. Claims **30 - 53** are pending. Claims **1 - 29** have been canceled. Claims **30, 38, 43, 48, 53** are independent.

Claim Rejections - 35 USC § 101

3. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

4. Claims **30 - 37** are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Claims **30 - 37** disclose an information signal, which is non-functional descriptive material per se such as music, literary works, or a compilation or mere arrangement of data.

When nonfunctional descriptive material is recorded on some computer-readable medium, in a computer or on an electromagnetic carrier signal, it is not statutory since no requisite functionality is present to satisfy the practical application requirement. Merely claiming nonfunctional descriptive material, i.e., abstract ideas, stored on a computer-readable medium, in a computer, or on an electromagnetic carrier signal, does not make it statutory. Appropriate correction is required.

Claim Rejections - 35 USC § 102

Art Unit: 2136

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102(e) that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

6. Claims **30, 35, 37** are rejected under 35 U.S.C. 102 (e) as being anticipated by **Moskowitz et al.** (US Patent No. **5,889,868**).

With Regards to Claim 30, Moskowitz discloses an information signal embodied on a computer readable medium, the information signal comprising:

- a) electronic content; (see Moskowitz col. 2, lines 26-30: audio, video, and other multimedia works (electronic content)) and
- b) control information for controlling at least one predefined use of the electronic content; (see Moskowitz col. 2, lines 62-65: force degradation of content if watermark removed; control attempt to create copy of content)
- c) wherein the control information is a substantially invisible and substantially indelible part of the information signal. (see Moskowitz col. 10, lines 15-18: watermark integrated as closely as possible with content)

With Regards to Claim 35, Moskowitz discloses an information signal as in claim 30, in which the control information is intertwined with the electronic content. (see Moskowitz

col. 10, lines 15-18: watermark (information control signal) integrated (intertwined) with content signal)

With Regards to Claim 37, Moskowitz discloses an information signal as in claim 30, wherein the computer readable medium is one of: a DVD, a video cassette tape, a magnetic disk, an optical disk, and a network. (see Moskowitz col. 6, lines 44-45: optical disk (CD); delivery mechanism)

Claim Rejections – 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims **31 - 34, 36, 38 - 53** are rejected under 35 U.S.C. 103 (a) as being unpatentable over **Moskowitz** in view of **Stefik et al.** (US Patent No. **5,629,980**).

With Regards to Claims 31, 46, 49, Moskowitz discloses an information signal as in claims 30, 43, 48, in comprising control information. (see Moskowitz col. 3, lines 18-22: carry watermark control information carried in content signal) Moskowitz does not specifically disclose an indication of whether the electronic content may be copied. However, Stefik disclose wherein an indication of whether the electronic content may be

Art Unit: 2136

copied. (see Stefik col. 34, lines 34-40: control information; indication content can be copied)

It would have been obvious to one of ordinary skill in the art to modify Moskowitz for an indication content may be copied as taught by Stefik. One of ordinary skill in the art would have been motivated to employ the teachings of Stefik in order to enable the capability for a distribution system where the means for billing is always transported with the work. (see Stefik col. 3, lines 45-47: “ ... *It would be desirable to have a distribution system where the means for billing is always transported with the work. ...* ”)

With Regards to Claims 32, 39, 47, Moskowitz discloses an information signal as in claims 30, 38, 43, in comprising control information. (see Moskowitz col. 3, lines 18-22: carry watermark control information carried in content signal) Moskowitz does not specifically disclose a number of times the electronic content may be used. However, Stefik discloses wherein a number of times the electronic content may be used on a given appliance. (see Stefik col. 34, lines 34-40: make one or more copies (number of copies) of the digital work)

It would have been obvious to one of ordinary skill in the art to modify Moskowitz for an indication of the number of times content may be copied as taught by Stefik. One of ordinary skill in the art would have been motivated to employ the teachings of Stefik in order to enable the capability for a distribution system where the means for billing is always transported with the work. (see Stefik col. 3, lines 45-47)

With Regards to Claims 33, 40, Moskowitz discloses an information signal as in claims 30, 38, wherein comprising control information. (see Moskowitz col. 3, lines 18-22: carry watermark control information carried in content signal) Moskowitz does not specifically disclose content may only be copied to appliances capable of enforcing the control information. However, Stefik discloses wherein an indication that the content may be copied only to appliances capable of enforcing the control information. (see Stefik col. 3, lines 59-60: digital works may only be accessed by other secure repositories)

It would have been obvious to one of ordinary skill in the art to modify Moskowitz where content is copied only to appliances that are capable of enforcing the control information as taught by Stefik. One of ordinary skill in the art would have been motivated to employ the teachings of Stefik in order to enable the capability for a distribution system where the means for billing is always transported with the work. (see Stefik col. 3, lines 45-47)

With Regards to Claims 34, 41, Moskowitz discloses an information signal as in claims 30, 38, in which the control information comprises an expiration date after which the electronic content cannot be used. (see Moskowitz col. 3, lines 18-22: carry watermark control information carried in content signal) Moskowitz does not specifically disclose an expiration date. However, Stefik discloses wherein an expiration date after which the electronic content cannot be used. (see Stefik col 49, ll 55-57: expiration time period for usage rights)

It would have been obvious to one of ordinary skill in the art to modify Moskowitz

Art Unit: 2136

for an expiration date after which the electronic content cannot be used as taught by Stefik. One of ordinary skill in the art would have been motivated to employ the teachings of Stefik in order to enable the capability for a distribution system where the means for billing is always transported with the work. (see Stefik col. 3, lines 45-47)

With Regards to Claim 36, Moskowitz discloses an information signal as in claim 30. (see Moskowitz col. 3, lines 18-22: carry watermark control information carried in content signal) Moskowitz does not specifically disclose that at least one predefined use is selected from the group consisting of: copying the information signal from one electronic device to another, converting the information signal to analog form, converting the information signal to digital form, and rendering the information signal. However, Stefik discloses wherein rendering the information signal. (see Stefik col 36, lines 29-32: play (render) content through a transducer such as a speaker or display device)

It would have been obvious to one of ordinary skill in the art to modify Moskowitz for the selection of one predefined use as taught by Stefik. One of ordinary skill in the art would have been motivated to employ the teachings of Stefik in order to enable the capability for a distribution system where the means for billing is always transported with the work. (see Stefik col. 3, lines 45-47)

With Regards to Claim 38, Moskowitz discloses a rights management method comprising the steps of:

- (a) receiving an information signal at a first device, the information signal comprising a content portion and steganographically encoded control information, the control information comprising an indication of whether at least part of the content portion may be copied; (see Moskowitz col. 10, lines 15-18: signal includes watermark (control information))
- (b) steganographically decoding the received information signal to recover the control information; (see Moskowitz col. 3, lines 18-22: decode watermark (control information) from signal)

Moskowitz does not specifically disclose copying the content.

However, Stefik discloses:

- (c) using the control information to determine whether at least part of the information signal may be copied to a second device; (see Stefik col. 34, lines 34-40: control information; indication content can be copied) and
- (d) copying at least part of the information signal to the second device if permitted by the control information. (see Stefik col. 34, lines 34-40: control information; indication content can be copied)

It would have been obvious to one of ordinary skill in the art to modify Moskowitz for copying the content as taught by Stefik. One of ordinary skill in the art would have been motivated to employ the teachings of Stefik in order to enable the capability for a distribution system where the means for billing is always transported with the work. (see Stefik col. 3, lines 45-47)

With Regards to Claim 39, Moskowitz discloses a method as in claim 38, in which the control information further comprises an indication of a number of times the content may be rendered by a given device. (see Moskowitz col. 3, lines 18-22: carry watermark control information carried in content signal) Moskowitz does not specifically disclose a number of times the content may be rendered. However, Stefik discloses wherein an indication of a number of times the content may be rendered by a given device. (see Stefik col 37, lines 18-22: number of copies in print request (number of times content may be rendered))

It would have been obvious to one of ordinary skill in the art to modify Moskowitz for a number of times the content may be rendered as taught by Stefik. One of ordinary skill in the art would have been motivated to employ the teachings of Stefik in order to enable the capability for a distribution system where the means for billing is always transported with the work. (see Stefik col. 3, lines 45-47)

With Regards to Claim 42, Moskowitz discloses an information signal as in claim 38, in which the control information is intertwined with the electronic content. (see Moskowitz col. 10, lines 15-18: watermark (information control signal) integrated (intertwined) with content signal)

With Regards to Claim 43, Moskowitz discloses a method comprising:

- a) steganographically decoding an information signal to recover first control information; (see Moskowitz col. 3, lines 63-67: decode watermark signal based

on original watermark information)

- b) modifying, at least in part, the first control information to obtain second control information; (see Moskowitz col. 3, lines 59-60: inverting (modifying) watermark or control information) and
- c) steganographically encoding the second control information into the information signal. (see Moskowitz col. 3, lines 61-62: encode watermark including inverted watermark)

Moskowitz does not specifically disclose one governed operation on the information signal.

However, Stefik discloses:

- b) performing at least one governed operation on the information signal based at least in part on the recovered first control information; (see Stefik col. 34, lines 34-40: control information; indication content can be copied (governed operation))

It would have been obvious to one of ordinary skill in the art to modify Moskowitz to perform one governed operation on the information signal as taught by Stefik. One of ordinary skill in the art would have been motivated to employ the teachings of Stefik in order to enable the capability for a distribution system where the means for billing is always transported with the work. (see Stefik col. 3, lines 45-47)

With Regards to Claim 44, Moskowitz discloses a method as in claim 43, further

comprising: removing, at least in part, the first control information from the information signal. (see Moskowitz col. 3, lines 18-22: encoding and decoding (removing) watermarks or control information from signal)

With Regards to Claim 45, Moskowitz discloses a method as in claim 44, in which the removing step is performed before the steganographically encoding step. (see Moskowitz col. 4, lines 18-31: method for varying encode/decode algorithms)

With Regards to Claim 48, Moskowitz discloses a method comprising the steps of:

- (a) receiving a digital information signal, the digital information signal including control information steganographically encoded therein; (see Moskowitz col. 10, lines 15-18: signal includes watermark (control information))
- (b) recovering the control information from the digital information signal; (see Moskowitz col. 3, lines 18-22: decode watermark (control information) in a signal)
- (f) recovering the control information from the recorded information signal; (see Moskowitz col. 3, lines 18-22: decode watermark (control information) in a signal)

Moskowitz does not specifically disclose to govern at least one use of the information signal and rendering the information signal through an analog output.

However, Stefik discloses:

- (c) using the control information to govern at least one use of at least part of the digital information signal; (see Stefik col. 34, lines 34-40: control information; indication content can be copied (governed operation))

- (d) rendering at least part of the digital information signal through an analog output;
(see Moskowitz col. 36, lines 29-32: play (render) content with speakers (analog output))
- (e) recording the rendered information signal on a computer readable medium; (see Stefik col. 34, lines 34-40: control information; indication content can be copied)
- (g) using the control information to govern at least one use of the recorded information signal. (see Stefik col. 34, lines 34-40: control information; indication content can be copied (governed operation))

It would have been obvious to one of ordinary skill in the art to modify Moskowitz to govern at least one use of the information signal and rendering the information signal through an analog output as taught by Stefik. One of ordinary skill in the art would have been motivated to employ the teachings of Stefik in order to enable the capability for a distribution system where the means for billing is always transported with the work. (see Stefik col. 3, lines 45-47)

With Regards to Claim 50, Moskowitz discloses a method as in claim 48, comprising control information. Moskowitz does not specifically disclose a portion of the information signal may be rendered on an audio or video output. However, Stefik discloses wherein at least a portion of the information signal may be rendered on an audio or video output. (see Stefik col. 36, lines 29-32: play (render) signal in an audio (speaker) or video (display device))

It would have been obvious to one of ordinary skill in the art to modify Moskowitz

Art Unit: 2136

for a portion of the information signal to be rendered on an audio or video output as taught by Stefik. One of ordinary skill in the art would have been motivated to employ the teachings of Stefik in order to enable the capability for a distribution system where the means for billing is always transported with the work. (see Stefik col. 3, lines 45-47)

With Regards to Claim 51, Moskowitz discloses a method as in claim 50. (see Moskowitz col. 3, lines 18-22: carry watermark control information carried in content signal)

Moskowitz does not specifically disclose rendering on an audio output or not rendering on an audio output.

However, Stefik discloses:

- a) in which step (c) comprises determining, based at least in part on the control information, that the information signal may be rendered on an audio output, (see Moskowitz col. 36, lines 29-32: work sent through some kind of transducer, speaker (audio output)) and
- b) in which step (g) comprises determining, based at least in part on the control information, that the information signal may not be rendered on an audio output. (see Moskowitz col. 36, lines 29-32: work sent through some kind of transducer, display device)

It would have been obvious to one of ordinary skill in the art to modify Moskowitz for rendering on an audio output and not rendering on an audio output as taught by Stefik. One of ordinary skill in the art would have been motivated to employ the

Art Unit: 2136

teachings of Stefik in order to enable the capability for a distribution system where the means for billing is always transported with the work. (see Stefik col. 3, lines 45-47)

With Regards to Claim 52, Moskowitz discloses a method as in claim 48. (see Moskowitz col. 3, lines 18-22: carry watermark control information carried in content signal) Moskowitz does not specifically disclose the analog output comprises at least one of: a printer, a computer monitor, a television, and a speaker. However, Stefik discloses wherein the analog output comprises a speaker. (see Moskowitz col. 36, lines 29-32: play through a speaker (analog output))

It would have been obvious to one of ordinary skill in the art to modify Moskowitz for an analog output comprising a speaker as taught by Stefik. One of ordinary skill in the art would have been motivated to employ the teachings of Stefik in order to enable the capability for a distribution system where the means for billing is always transported with the work. (see Stefik col. 3, lines 45-47)

With Regards to Claim 53, Moskowitz discloses a rights management method comprising:

- a) receiving an information signal at a first device, the information signal including content and steganographically encoded control information; (see Moskowitz col. 10, lines 15-18: signal includes watermark (control information))
- b) steganographically decoding the information signal to recover the control information; (see Moskowitz col. 3, lines 18-22: decode watermark (control

information) in a signal)

Moskowitz discloses degrading the quality of the content. (see Moskowitz col. 2, lines 62-65: degrading of content when attempts to remove watermarks) Moskowitz does not specifically disclose rendering of the content.

However, Stefik discloses:

- c) using the control information to govern at least one rendering of the content. (see Stefik col. 34, lines 34-40: control information; indication content can be copied (governed operation))

It would have been obvious to one of ordinary skill in the art to modify Moskowitz govern at least one rendering of the content as taught by Stefik. One of ordinary skill in the art would have been motivated to employ the teachings of Stefik in order to enable the capability for a distribution system where the means for billing is always transported with the work. (see Stefik col. 3, lines 45-47)

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Carlton V. Johnson whose telephone number is 571-270-1032. The examiner can normally be reached on Monday thru Friday , 8:00 - 5:00PM EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Nasser Moazzami can be reached on 571-272-4195. The fax phone

Art Unit: 2136

number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Carlton V. Johnson
Examiner
Art Unit 2136

CVJ
April 14, 2008

/Nasser G Moazzami/
Supervisory Patent Examiner, Art Unit 2136